

### **Remarks**

Claims 1-16 were pending in the application. Claims 1-16 have now been canceled. New claims 17-26 have now been added. New claims 17-26 generally correspond to those claims of the issued European counterpart, i.e. European Patent No. EP1702466B1.

As an initial matter, pursuant to M.P.E.P. §609.03, Applicant respectfully requests that the Examiner indicate that those documents listed in the International Search Report filed on June 22, 2006, as indicated on Form PCT/DO/EO/903, have been considered during the examination of the present application. No such indication was provided in the office action.

#### **I. General Claim Objections**

The Examiner has made certain objections to the claims based upon certain informalities. Applicant has provided a new set of claims 17-26 that are now believed to overcome the Examiner's objections.

#### **II. Rejection Under 35 U.S.C. §112, Second Paragraph**

The previously pending claims 1, 4, 10 and 12 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicant has submitted new claims 17-26 that are believed to be acceptable. Applicant respectfully requests that the rejection made upon this basis be withdrawn.

#### **III. Rejection Under 35 U.S.C. §101**

Claims 1-12 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter as being drawn to method claims to process steps that are not tied to a particular machine.

New claims 17-23 are drawn to a method, with independent method claims 17 and 20 calling for the method to be carried out using an apparatus. Applicants respectfully submit that the claimed method is therefore tied to a particular machine to meet the statutory subject matter requirement of 35 U.S.C. §101.

#### **IV. Rejections Under 35 U.S.C. §102/§103**

The Examiner has rejected pending claims 1-16 as being anticipated under §102 or obvious under §103, based upon the reference Thomas et al. (U.S. Pat. App. Pub. No. US2003/0093580), alone or in combination with the reference Zaslow (“If TiVo Considers You Gay, Here is How to Set Record Straight; With Low Profile – Digital Recorder’s Video Selections For Its Users Can Give Them Pause”. Wall Street Journal. (Europe). Brussels: Nov. 28, 2002).

Applicant submits that none of the references cited and relied on by the Examiner anticipate or provide a *prima facie* case of obviousness of the presently presented claims 17-26.

An invention is said to be “anticipated” only if each and every element set forth in the claim is found, either expressly or inherently, within a single prior art reference. *Verdegall Bros. V. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). And in order to establish a *prima facie* case of obviousness, the scope and content of the prior art are determined; differences between the prior art and the claims at issue are ascertained and the level of ordinary skill in the pertinent art resolved. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (U. S. Sup. Ct., 1966); *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, \_\_\_\_\_, 82 USPQ 2d 1385, 1388 (U.S. Sup. Ct., 2007). Once the *Graham* factors have been established, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. See M.P.E.P. §2141(III). Although the prior art references when combined need not teach or suggest all the claim limitations, the Examiner must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. *Id.*

Applicant’s new independent claim 17 requires a method of recommending content including the features of obtaining a comprehensive degree of interest and an alert level and subsequently weighting the comprehensive degree of interest by the comprehensive alert level.

Applicant’s new independent claim 20 calls for a method of updating a user profile including the feature of obtaining feedback information of the content information from the user and obtaining an alert characteristic, determining an alert level from the

alert characteristic parameters and weighting the feedback information by the comprehensive alert level and subsequently updating the user profile according to the weighted feedback information.

New independent claims 24 and 25 are apparatus claims directed to an apparatus for recommending content and updating a user profile, respectively.

It is apparent that weighting the comprehensive degree of interest or feedback information is a novel feature. The result of the weighting is that the recommendation system can recommend more cautiously and accurately in respect of the user's profile. This weighting is not taught, shown or suggested by the cited art. It is therefore respectfully submitted that the currently presented claims are novel and that the cited references do not provide a *prima facie* case of obviousness with respect to the claims. Accordingly, new claims 17-26 should be allowed over the cited art.

## **V. Conclusion**

In view of all of the reasons presented above, Applicant submits that the application is in a condition for allowance. Favorable action is therefore respectfully requested.

If any further extension of time is believed necessary, such extension is hereby by requested. If any fees are deemed necessary for the continued prosecution of the present application, the Commissioner is hereby authorized to charge them to Deposit Account No. 50-1899.

Please contact the undersigned at the address or telephone number listed below should there be any questions, or if contacting the undersigned would expedite or aid the examination or prosecution of this application.

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Respectfully submitted,

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